

REMARKS

Claims 17-22 are presently pending. Claims 1-16 were previously cancelled without prejudice. Claims 20-22 are added.

Claims 17-19 were rejected under 35 U.S.C. 102(e) as being anticipated by US Patent Publication 2006/0026637 to Gatto.

Claims 17 recites, among other limitations, "a video decoder for decompressing a plurality of compressed video streams". However, Gatto teaches and Examiner cites Gatto, [0040]¹, teaching "The graphics engine 192 may include, for example, one or more (MPEGx, for example where x = 1, 2 or 4) vdeo encoders 144 coupled to a Central Processing Unit (CPU) 146, which CPU 146 is coupled to one or more (MPEGx, for example) video decoders 154." Examiner appears to conclude from the foregoing that Gatto teaches "the input being configured to accept a plurality of input streams and input of a plurality of input streams to the decoder must be compressed or encoded streams." Office Action at 3.

However, if Examiner concludes that "a plurality of input streams to the decoder must be compressed or encoded streams" because Gatto teaches "one or more ... video decoders 154" at paragraph 0040, then Gatto does not teach "a video decoder" (noted that "video decoder" is referred to in the singular context) "for decompressing a plurality of compressed video streams".

Moreover, Assignee has added claim 20 that recites, among other limitations, "a single video decoder decompresses the plurality of compressed video streams,

¹ Examiner actually cited paragraph 0046 in the Office Action at 3. However, Gatto paragraph 46 does not include the passage quoted by

thereby resulting in the plurality of decompressed video streams, wherein each of said decompressed video streams comprises the plurality of pictures". Gatto clearly does not teach the foregoing.

Claim 17 recites, among other limitations, "a register for indicated a past prediction picture, and a future prediction picture for each of the plurality of compressed video streams".

Examiner has indicated that Gatto discloses "a register for indicating a past prediction picture, and a future prediction picture for each of the plurality of compressed video streams (paragraph 0009 shows MPEG which comprises I, P, and B frames and since MPEG involves predictive coding, registers or frame memories must be reserved at the decoder so one can predict pictures in the GOP based on those stored reference frames)".

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987); see also MPEG 2131.

It is noted that even if Gatto, paragraph 0009 discloses MPEG, and even if "MPEG involves predictive coding", Gatto's disclosure that "The hardware video encoder and the hardware video decoder may conform to a Motion Pictures Expert Group (MPEG) standard" is not express disclosure of "a register for indicating a past prediction picture, and a future prediction picture for each of the plurality of compressed video streams".

Examiner. After reviewing the reference, it is believed that Examiner intended to cite Gatto, paragraph 0040.

Accordingly, to the extent that claim 17 is rejected under 35 U.S.C. § 102(e) because Gatto, expressly describes "a register for indicating a past prediction picture, and a future prediction picture for each of the plurality of compressed video streams", Assignee respectfully traverses the rejection to claim 17 and dependent claims 18 and 19.

To the extent that Examiner asserts that "a register for indicating a past prediction picture, and a future prediction picture for each of the plurality of compressed video streams", Assignee also traverses.

The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (reversed rejection because inherency was based on what would result due to optimization of conditions, not what was necessarily present in the prior art); *In re Oelrich*, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981). "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.' " *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (citations omitted). "In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Ex parte Levy*, 17

USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original). See also MPEP 2112.

Examiner has indicated that "since MPEG involves predictive coding, registers or frame memories must be reserved at the decoder so one can predict pictures in the GOP based on those stored reference frames". As an initial matter, if "registers or frame memories must be reserved", then "registers" are not necessarily present.

Moreover, that registers and/or frame memories "must be reserved at the decoder so one can predict pictures in the GOP based on those stored reference frames" is not a teaching of "a register for indicating a past prediction picture, and a future prediction picture for each of the plurality of compressed video streams". Accordingly, Assignee respectfully traverses the rejection to claim 17 and dependent claims 18 and 19.

Claim 18 was rejected under 35 U.S.C. § 102(e) as being anticipated by Gatto. Claim 18 recites, among other limitations, "wherein the video decoder motion compensates motion estimated pictures in each of the plurality of compressed video streams using at least the past prediction pictures indicated by said registers for each of the plurality of compressed video streams."

Examiner has indicated that the foregoing is "inherently included in the MPEG standards". Assignee respectfully traverses, and submits that "motion compensates ... using at least the past prediction pictures indicated by said register for each of the plurality of compressed video streams", is not required by the MPEG standards. Accordingly, Assignee respectfully traverses the rejection to claim 18.

Newly added claim 20 recites, among other limitations, "wherein the display engine examines the register, selects the pictures indicated by the register for display, and concatenates the pictures indicated for display by the register". Gatto does not teach the foregoing and it is respectfully submitted that even if "registers or frame memories must be reserved at the decoder so one can predict pictures in the GOP based on those stored reference frames", the foregoing would not require "the display engine examines the register, selects the pictures indicated by the register for display, and concatenates the pictures indicated for display by the register".

Newly added claim 21 recites, among other limitations, "wherein the display engine examines the register, selects the pictures indicated by the register for display, and concatenates the pictures indicated for display by the register". Gatto does not teach the foregoing and it is respectfully submitted that even if "registers or frame memories must be reserved at the decoder so one can predict pictures in the GOP based on those stored reference frames", the foregoing would not require "the display engine examines the register, selects the pictures indicated by the register for display, and concatenates the pictures indicated for display by the register".

wherein the display engine requests the pictures indicated by the register for display, from a frame buffer.

Conclusion

For at least the foregoing reasons, Assignee respectfully submits that each of the pending claims are in a condition for allowance and Examiner is respectfully requested to pass this case to issuance. It is believed that no fee is due, however, to the extent that any fee is due, the Commissioner is hereby authorized to charge such fee to charge account 13-0017.

February 15, 2008

Respectfully submitted,



Mirut Dalal
Attorney for Applicant(s)
Registration No. 44,052

McANDREWS, HELD & MALLOY, LTD.
500 W. Madison - 34th Floor
Chicago, IL 60661
Phone: (312) 775-8000